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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,234	09/25/2001	Jarett L. Rinaldi	2207/12122	7885

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KENYON & KENYON (SAN JOSE)  
333 WEST SAN CARLOS ST.  
SUITE 600  
SAN JOSE, CA 95110

EXAMINER

MITCHELL, JAMES M

ART UNIT PAPER NUMBER

2827

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/965,234

Applicant(s)

RINALDI ET AL.

Examiner

James Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 21-23 and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishinaga et al. (U.S. 6,093,940).
3. Ishinaga (Fig 1, 3A, 4) discloses a surface mount device light emitting diode package, comprising: a circuit board housing (6,7) attached to a printed circuit board (10), a first light emitting diode (2a) and a second light emitting diode (2b) supported by said circuit board housing and soldered (9) to the board, wherein said first and second LED are inherently coupled to the printed board via cathode and anode (20, 21 and 22) patterned into the housing (Fig 4, 4"; via bottom portion of housing surrounding LED); and a plurality of electrical terminals (7) extending on the outside of the housing with contacts adapted for surface mounting, wherein first and second LED are stacked in a line, a line of LED die is adapted to form a right angle with respect to the circuit board (see Fig 4) when the package, a die inherently form a single wafer.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5, 7-12, 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishinaga.

7. The prior art discloses the elements stated in paragraph 3, but does not explicitly disclose that the molding for the housing was an epoxy layer. Examiner takes official notice that it would have been obvious to one of ordinary skill in the art to form the molding of epoxy in order to protect the device, because it has been held that to be within the general skill of a worker in the art to select known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (1960).

8. Further, the prior art discloses the claimed invention except for a showing that the LED has an array of die having at least two rows and two columns or a third and fourth LED forming a two by two matrix. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a LED with an array of die

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having at least two rows and two columns and to form a third and fourth LED, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *In re Harza*, 124 U.S.P.Q 378 (CCPA 1960).

9. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Ishinaga as applied 4 in combination with Yoshida (05-131499).

10. The prior art does not appear to disclose a reinforcing pin, however Yoshida utilizes a reinforcing pin (Fig 12).

11. It would have been obvious to one of ordinary skill in the art to incorporate a reinforcing pin to the housing of the prior art in order to prevent deformation as taught by Yoshida (English Abstract).

### **Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mitchell whose telephone number is (703) 305-0244. The examiner can normally be reached on M-F 10:30-8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (703) 305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3432 for regular communications and (703) 305-3230 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Jmm

October 1, 2002

*Albert W. Paladini 10-1-02*  
**ALBERT W. PALADINI**  
**PRIMARY EXAMINER**